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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,958	10/01/2003	Joe Shochet	54317-023301	9262
46560 7590 04/15/2008 THE WALT DISNEY COMPANY C/O GREENBERG TRAURIG LLP 2450 COLORADO AVENUE SUITE 400E SANTA MONICA, CA 90404			EXAMINER LIU, LIN	
			ART UNIT 2145	PAPER NUMBER
			MAIL DATE 04/15/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/677,958	<b>Applicant(s)</b> SHOCHET ET AL.	
	<b>Examiner</b> LIN LIU	<b>Art Unit</b> 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01/31/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/22/2008</u>  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is responsive to communications filed on 01/31/2008.

Claims 1-7, and 24-28 are pending and have been examined.

2. The information disclosure statement (I.D.S) filed on 01/22/2008 is considered.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims **1-7, and 24-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Harvey et al. (PGPUB: US 2002/0059379 A1)** in view of **Maehiro (PGPUB: US 2002/0062348 A1)**.

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With respect to **claim 1**, Harvey teaches a method for initiating communication in real-time between two users in a multi-user communication environment (Harvey: fig. 1), the method comprising:

providing an invitation generated by a multi-user communication environment to a first user in the multi-user environment during communication between the first user and a second user, the invitation being transmitted by the first user to a second user outside of the multi-user communication environment (Harvey: fig. 3, noted step 258, page 7, paragraphs 64-66 and page 8, paragraph 71, noted that the user requests to create a personal invitation by sending other users' communication addresses and personal invitations to the central controller module 115);

wherein the second user initiates real-time and secure communication with the first user after the second user receives the personal invitation by launching the invitation application to the multi-user environment and the invitation is authenticated in the multi-user communication environment (Harvey: fig. 3, page 7, paragraph 66 and page 13, paragraphs 127-128, noted that the invited user is approved by the central controller and launches the application to establish a communication with the community.).

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and

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page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the invitation data format as taught by Maehiro in Harvey's invention in order to allow the server to efficiently identify the area of the database (Harvey: page 1, paragraph 14).

With respect to **claim 2**, Harvey teaches the method according to claim 1, wherein the invitation is provided by the multi-user communication environment (Harvey: fig. 1, and page 7, paragraphs 64-67.).

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

With respect to **claim 3**, Harvey teaches the method according to claim 2, wherein the multi-user communication environment is an online multiplayer gaming environment (Harvey: fig. 6, page 4, paragraph 39 and page 12, paragraphs 121-123, gaming environment.).

With respect to **claim 4**, Harvey teaches the method according to claim 1, wherein the invitation is transmitted by the first user through at least one of an email program, a telephone conversation, a handwritten note, a chat room

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program, direct communication, a instant message program, and a facsimile (Harvey: page 7, paragraph 64.).

With respect to **claim 5**, Harvey teaches the method according to claim 1, wherein the first user initiates real-time and secure communication with the second user after the code is authenticated in the multi-user communication environment (Harvey: page 7, paragraph 66 and page 13, paragraphs 127-128).

With respect to **claim 6**, Harvey teaches the method according to claim 1, wherein the code comprises a sequence of symbols (Harvey: fig. 3, page 7, paragraphs 64-66 and page 13, paragraph 127, noted the invitation message.).

With respect to **claim 7**, Harvey teaches all of the claimed limitations, except that he does not explicitly teach that the code comprises a sequence of alpha-numeric symbols.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

With respect to **claim 24**, Harvey teaches a readable media having instructions for facilitating communication in real-time between two users in a multi-user communication environment, the instructions performing steps comprising:

allowing the two users to communicate within the multi-user communication environment by selecting from a menu of pre-determined words (Harvey: fig. 4, page 9, paragraphs 83, & 91, noted the community GUI.);

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providing an invitation generated by the multi-user communication environment to a first one of the two users in the multi-user communications environment while communications are being exchanged between the two users, wherein the menu fails to provide for the transmission of the unique code to the other of the two users thus requiring the invitation to be transmitted by the first one of the two users to the other of the two users via a mode outside of the multi-user communication environment (Harvey: fig. 3, noted step 258, page 7, paragraphs 64-66 and page 8, paragraph 71, noted that the user requests to create a personal invitation by sending other users' communication addresses and personal invitations to the central controller module 115); and

allowing the other of the two users to transmit free form communications to the first one of the two users upon the other of the two users launching the invitation application generated by the multi-user environment to the multi-user communications environment for authenticating the invitation with the multi-user communication environment (Harvey: fig. 3, page 7, paragraph 66 and page 13, paragraphs 127-128, noted that the invited user is approved by the central controller and launches the application to establish a communication with the community.)

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and

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page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the invitation data format as taught by Maehiro in Harvey's invention in order to allow the server to efficiently identify the area of the database (Harvey: page 1, paragraph 14).

In regard to **claim 25**, the limitations of this claim are substantially the same as those in claim 6. Therefore the same rationale for rejecting claim 6 is used to reject claim 25. By this rationale **claim 25** is rejected.

In regard to **claim 26**, the limitations of this claim are substantially the same as those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject claim 26. By this rationale **claim 26** is rejected.

With respect to **claim 27**, Harvey teaches the readable media according to claim 24, wherein the invitation is provided in response to a request by the first one of the two users (Harvey: fig. 3, page 7, paragraphs 64-66 and page 13, paragraph 127).

With respect to **claim 28**, Harvey teaches the readable media according to claim 24, wherein the unique code is valid for a limited period of time (Harvey: fig. 5, page 11, paragraphs 112-113).



***Response to Arguments***

6. Applicant's arguments filed on 01/31/2008 have been fully considered but they are not persuasive.

7. On pages 4-5 of Applicant's remark, Applicant argues that the combined method of Harvey and Maehiro fails to teach "that the unique code is generated by the communications environment during a communication exchange within the environment. This code is then transmitted to the first user, who then, via a mode outside of the environment, communicates the unique code to a second user, who then submits the code to the environment for authentication. Only then is real time and secure communication established between the two users". The examiner disagrees. The explanation and citing of the reference for the amended parts can be found in the claims above.

8. Applicant has had an opportunity to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

9. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As

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the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

10. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. L./  
/Lin Liu/

Examiner, Art Unit 2145

/Jason D Cardone/  
Supervisory Patent Examiner, Art Unit 2145